

Application No. 10/748,424

REMARKS

Claims 1, 3-8, 10-15, 17-23, 25 and 26 are pending. By this Amendment, claims 2, 9, 16 and 24 are cancelled, and claims 1, 4, 8, 11, 15, 18, 23 and 26 are amended. The amendments to claims 1, 8, 15 and 23 are supported by the specification at, for example, pages 21-23, and by claims 2, 9, 16 and 24, as filed. No new matter is introduced by the present amendment.

Claims 1, 3-8, 10-15, 17-23, 25 and 26 currently stand as rejected. Applicants respectfully request reconsideration of the rejections based upon the following remarks.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 1 and 23 under 35 U.S.C. § 112, first paragraph, asserting that claims 1 and 23 contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. More specifically, the Examiner asserted that the claims did not comply with the enablement requirement, asserting that the bonding of Z-X is only taught by a carboxyl group linkage and only in one position. Applicants submit that the original claims are fully enabled by the specification such that one of ordinary skill in the art could make and use the invention. However, Applicants note that claims 1 and 23, as presently claimed, include the linkage between Z-X as described in the specification at, for example, pages 21-23. Additionally, the specification discloses the synthesis of various compounds having the claimed Z-X linkage, where the Z-X linkage contains an oxygen or sulfur atom. See specification at, for example, pages 25-38. With respect to compounds having a Z-X linkage comprising a nitrogen atom or amine group, the specification discloses general synthesis methods to prepare these types of compounds on pages 23-24. As such, one of ordinary skill in the art could prepare the compounds within the scope of claims 1 and 23 without undue

Application No. 10/748,424

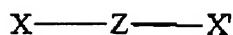
experimentation. Thus, claims 1 and 23 are enabled, and Applicants respectfully request the withdrawal of the rejection of claims 1 and 23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Rejections Under 35 U.S.C. § 103

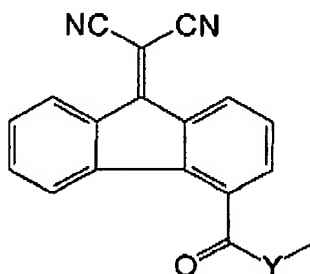
The Examiner rejected claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over JP-9-316036 or JP-9-265198 in view of U.S. Patent 4,835,081 to Ong et al (the Ong patent). More specifically, the Examiner asserted that, "both Japan patents teach the use of fluorencarboxylic acid esters as electron-transporting materials for electrophotographic photoreceptors. Ong teaches the imaging member and method of using a photogenerator component having a charge transport component an electron transport component and a polymeric binder with the single malononitriles." The Examiner further asserted that, "it would have been obvious to one of ordinary skill in the art at the time of applicants' invention with a reasonable expectation of success to use the apparatus and imaging process with an organophotoreceptor having the dimmer with two malononitriles as the electron transporting materials as taught in either Japan reference." Applicants respectfully request reconsideration of the rejection based upon the following comments.

In order to establish prima facie obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP § 2143. With respect to JP-9265198 and JP-9316036, those references relate to compounds having a COO-R-OOC group that connected two fluorenylidene groups. In contrast, Applicants invention, as claimed in independent claims 1, 8, 15 and 23, relates to a charge transport material having the formula

Application No. 10/748,424



where X and X' each independently, have the formula



where Y is O-CH₂-CH₂-O, S, or NR₈ and R₈ is H, an alkyl group, an alkenyl group, an aromatic group, or a heterocyclic group. Since neither JP-9265198, JP-9316036 nor the Ong patent, which was cited by the Examiner for teaching an imaging member and method of using a photogenerator, teach or suggest the Z-X linkage of Applicants' claimed invention, the combination of either JP-9265198 or JP-9316036 with the Ong patent does not render Applicants' claimed invention prima facie obvious.

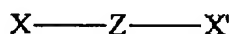
Since the combination of either JP-9265198 or JP-9316036 with the Ong patent does not render Applicants' claimed invention prima facie obvious, Applicants respectfully request the withdrawal of the rejection of claims 1-22 under 35 U.S.C. §103(a) as being unpatentable over JP-9-316036 or JP-9-265198 in view of the Ong patent.

Rejections Under 35 U.S.C. § 102

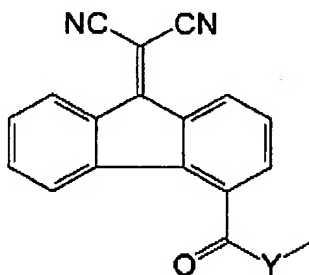
The Examiner rejected claims 23-26 under 35 U.S.C. § 102(b) as being anticipated by either JP-9-316036 or JP-9-265198. More specifically, the Examiner asserted that both references "teach a compound with two malononitriles groups on a compound that has electron

Application No. 10/748,424

transport ability." As discussed above, the JP-9-265198 and JP-9-316036 references relate to compounds having a COO-R-OOC group that connects two fluorenylidene groups. In contrast, Applicants invention, as claimed in independent claim 23, relates to a charge transport material having the formula



where X and X' each independently, have the formula



where Y is O-CH₂-CH₂-O, S, or NR₃ and R₃ is H, an alkyl group, an alkenyl group, an aromatic group, or a heterocyclic group. Since neither the JP-9-265198 nor the JP-9-316036 reference disclose this feature of Applicants' claimed invention, neither the JP-9-265198 nor the JP-9-316036 reference prima facie anticipate Applicants' invention, as presently claimed in independent claim 23. Since neither the JP-9-265198 nor the JP-9-316036 reference prima facie anticipate Applicants' invention, as claimed in independent claim 23, Applicants respectfully request the withdrawal of the rejection of claims 23-26 under 35 U.S.C. § 102(b) as being anticipated by either JP-9-316036 or JP-9-265198.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

Application No. 10/748,424

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Brian L. Jarrells
Registration No. 53,067

Customer No. 24113
Patterson, Thuent, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 252-1535